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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/707,510
Filing Date: December 18, 2003
Appellant(s): RYAN ET AL.

George M. Macdonald
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9 March 2009 appealing from the Office action

mailed 9 October 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0044586	GULLO et al.	3-2004
2003/0101147 A1	MONTGOMERY et al.	5-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.   Claim **1** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, support has not been found for the limitation, "paying the refund request substantially immediately after receiving the request and before review of the refund request to determine validity". Appropriate correction is required in the indicated claims and any subsequent claims.

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claim **1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 1**, the recitation, "*substantially*" is vague and indefinite. It is unclear to the

Office what the applicant means by the term. Appropriate correction is required in the indicated

claims and any subsequent claims.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims **1, 3-12, 14** and **16-23** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gullo et al., Pub. No. US2004/0044586 in view of Montgomery et al., Pub. No.

US2003/0101147 A1, hereinafter referred to as Gullo and Montgomery, respectively.

As per **Claim 1**, Gullo discloses a method for processing a postage refund

request for a mail piece comprising:

- receiving a refund request including a tracking identifier from a user system (0015);

- determining if the refund request is valid (0018-0019);

- if the refund request is not valid, initiating a refund error process, wherein (0018-
    0019, also see Figure 2),

- the determination of whether the refund request is valid includes determining whether
    the tracking identifier has been observed in a mail stream (0019-0020).

Gullo fails to disclose processing and paying the refund request substantially immediately

after receiving the request and before review of the refund request to determine validity.

Montgomery teaches the refund inquiry can take a variety of formats…(1) two or more

transactions…(1) the end user's account will be credited for the misprint; (2) the misprint

postage transaction information will be date/time stamped in the postage database and flagged as

"refunded"; (3) a refund request is issued to postage refund request and (4) the refunded postage

transaction is entered into a statusing database, so that the delivery status can be checked for six

months (0170). Thus, Montgomery teaches if two or more transactions occur, then a user's

account will be credited for the misprints, after which monitoring of the statusing database will

occur to determine the validity of the refund.

Gullo discloses processing a refund request (0019-0020). Gullo fails to *explicitly*

disclose monitoring the tracking identifier after processing the refund request in order to

determine if the mail piece is used after a refund payment. Gullo discloses the information

should further be processed to ensure that the particular IBI associated with the tracking/label

number and/or that there is not an active scan event for the tracking/label number (0019).

Montgomery teaches the end user's account will be credited for the misprint; the misprint

postage transaction information will be date/time stamped in the postage database and flagged as

"refunded"; a refund request is issued to a postage refund center and the refunded postage

transaction is entered into a statusing database, so that the delivery status can be checked for six

months (determining if the refund request is valid) (0170, 0188). Montgomery shows that the

step of providing a refund then determining if the transaction has been subsequently used.

Further, Montgomery teaches the postal authority enters the refunded postage transaction into the

master tracking computer system, where the delivery status can be checked for six more

months…the refunded postage polling module periodically polls the tracking information

database to determine if a mail piece associated with any refunded postage transaction has been

delivered (0188).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify the method and system of Gullo and include providing a refund

then processing the refund request for validity and monitoring for the scan events of the

transaction as taught by Montgomery since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same function

as it did separately, and one of ordinary skill in art would have recognized that the results of the

combination were predictable.

As per **Claim 3**, Gullo discloses the refund error process includes a fraud inquiry (0019-

0021).

As per **Claim 4**, Gullo fails to *explicitly* disclose the refund error process includes

notifying a postal authority. However, Gullo discloses a system that may be carried out online or

by directly going to a local post office. Therefore, when a user receives a refund error from the

system (operated by the USPS) they are receiving the notification from the postal authority

(Figure 1). Moreover, when a user has their account suspended for suspicion of fraud, they have

to contact the local post office to reactivate their account (0021). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of applicant's invention to modify the

method and system of Gullo and include notifying a postal authority, because it allows the postal

authority to suspend fraudulent postal accounts therefore preventing further fraud.

As per **Claim 5**, Gullo discloses determining if the mail piece is associated with the user

that submitted the refund request (0018).

As per **Claim 6**, Gullo fails to *explicitly* disclose determining if a refund test period has

completed; and if the refund test period is not completed, performing another determination of

whether the mail piece has been observed in the mail stream. However, Gullo discloses queuing

the request for a designated period, for example, seven days, to check for scan events (0019-

0020). Therefore, it would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify the method of Gullo and include queuing for scan events over a

designated period of time, because it allows the system to check multiple scan events over a

designated period of time to ensure that there is not an active scan event for the tracking/label

number (0019).

As per **Claims 7-10**, Gullo fails to disclose the tracking identifier includes a 22-

digit delivery confirmation PIC code, a PLANET code and a POSTNET code, a postage serial

number and a postage meter postage ascending register value, or a postal ID tag. However,

Montgomery teaches a method for detecting postage fraud using tracking identifiers. Further,

Montgomery discloses tracking identifiers being one or two-dimensional barcodes, PLANET or

POSTNET codes (0060-0063, see Figures 19-22). Further, Montgomery teaches associating the

information based indicium along with the tracking identifier, where the IBI contains ascending

register value, license zip, the certificate serial number, etc. (0080, 0096, also see Table 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to modify the method of Gullo and provide a tracking identifier that includes various

codes and pertinent information as taught by Montgomery, because it allows the system to

associate a plurality of information associated with the mail piece when attempting to track the

mail piece through the mail stream.

As per **Claims 11-12 and 16-18**, Gullo discloses sending the refund request to the postal

authority (see Figure 1). Gullo fails to disclose processing the refund request includes

aggregating a group of valid refund request associated with a postage broker, processing the

refund request includes aggregating a group of valid refund requests received from a plurality of

users and sending a group refund request associated with the aggregated group of valid refund

request to a postal authority, sending aggregated refund request data to the postage broker.

However, Montgomery teaches a refund eligible inquiry that allows a user or administrator

working on behalf of the mail user to poll eligible refund requests, where a user can select the

eligible refund requests to send to the USPS (000170-0171, 0174-175, see Figures 26-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to modify the method of Gullo and allow a user to choose from a plurality of postal

transaction to select the transactions that require a refund in order to send to the postal authority

as taught by Montgomery, because it allows a user to select the correct transaction or

transactions from a plurality of transactions and more efficiently process the refund requests in order to minimize the refund return around time.

As per **Claim 14**, Gullo discloses the refund test period is variable (0020). Gullo fails to disclose the variable length of the refund test period *depends upon the class of service of the mail piece*. However, Gullo discloses the amount of time that would be considered an undue period may depend on administrator preference, but a period of between about 1 and 30 days is preferred, with a period of about 10 days being considered optimal (0019). Further, Gullo discloses the queuing the request for a designated period, for example seven days, to check for scan events. (This period may be varied) (0020).

Montgomery teaches the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (0170, 0174).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo, and include many variable test periods as taught by Gullo and Montgomery since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 19**, Gullo discloses the tracking identifier is unique over a first period of time (0015).

As per **Claims 20 and 21** Gullo discloses a method for processing a postage refund request for a mail piece comprising:

- receiving a refund request including a tracking identifier from a user system (0015);

- determining if the refund request is valid (0018-0019);

- if the refund request is not valid, initiating a refund error process (0018-0019, also see Figure 2);

- if the refund request is valid, processing the refund request (0019-0020), wherein,

- the determination of whether the refund request is valid includes determining whether the tracking identifier has been observed in a mail stream (0019-0020).

Gullo fails to *explicitly* disclose receiving a plurality of refund requests from each of a respective plurality of user systems. However, Gullo discloses receiving a user request. The system of Gullo however is capable of receiving more than refund request. Further, Montgomery teaches a user interface which lists multiple transactions in which a user can select (see Figures 25-27). Moreover, Montgomery teaches a device ID that identifies the USPS-assigned ID for each postage vendor, and the user account for which the postage indicium will be issued (0096). Montgomery also teaches that the end user's account balance is securely stored in a centralized postage-issuing computer system (0003). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Gullo and include allowing a plurality of refund requests.

Gullo discloses the refund test period is variable and the refund request corresponding to a prior postage dispense operation associated with the user (0019-0020). Gullo fails to *explicitly* disclose the variable length of the refund test period *depends upon a tracking code lifetime*

period associated. However, Gullo discloses the amount of time that would be considered an

undue period may depend on administrator preference, but a period of between about 1 and 30

days is preferred, with a period of about 10 days being considered optimal (0019). Further,

Gullo discloses the queuing the request for a designated period, for example seven days, to check

for scan events. (This period may be varied) (0020). Also, Gullo discloses that the particular IBI

is associate with the tracking/label number and/or transaction number (0019). Further, Gullo

teaches a designated test period, where the period may be varied (0020). Moreover,

Montgomery teaches checking the delivery status for six months (0170, 0174, 0188). Therefore,

the references teach a variable test period associated with the tracking number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify the method and system of Gullo, and include many variable test

periods as taught by Gullo and Montgomery since the claimed invention is merely a combination

of old elements, and in the combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in the art would have recognized that the

results of the combination were predictable.

As per **Claim 22-23**, Gullo fails to *explicitly* disclose monitoring the tracking identifier

after processing the refund request in order to determine if the mail piece is used after a refund

payment, if the mail piece is used after a refund payment, assessing a postage fee and fine. Gullo

fails to *explicitly* disclose monitoring the tracking identifier after processing the refund request in

order to determine if the mail piece is used after a refund payment. Moreover, Gullo discloses

the information should further be processed to ensure that the particular IBI associated with the

tracking/label number and/or that there is not an active scan event for the tracking/label number

(0019). Furthermore, Gullo discloses tracking would permit the suspension of postage printing

capabilities for such users, and/or the reporting of the identity of such a user to a body capable of

taking further action against the user for submitting improper refund requests. It should be noted

that provision can be made for such a user to repay the amount they owe (0021, also see Claim

21).

Montgomery teaches the end user's account will be credited for the misprint; the misprint

postage transaction information will be date/time stamped in the postage database and flagged as

"refunded"; a refund request is issued to a potage refund center and the refunded postage

transaction is entered into a statusing database, so that the delivery status can be checked for six

months (determining if the refund request is valid) (0170, 0188). Montgomery shows that the

step of providing a refund then determining if the transaction has been subsequently used.

Further, Montgomery teaches the postal authority enters the refunded postage transaction into the

master tracking computer system, where the delivery status can be checked for six more

months…the refunded postage polling module periodically polls the tracking information

database to determine if a mail piece associated with any refunded postage transaction has been

delivered (0188).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to modify the method and system of Gullo and include providing a refund

then processing the refund request for validity, monitoring for the scan events of the transaction

and assessing a penalty for fraudulent use of postage as taught by Gullo and Montgomery since

the claimed invention is merely a combination of old elements, and in the combination each

element merely would have performed the same function as it did separately, and one of ordinary

skill in art would have recognized that the results of the combination were predictable.

(10) Response to Argument

First Issue

Appellant argues (with respect to claim1) that the current Specification supports the

amendment filed 26 June 2008 which reads, paying the refund request substantially immediately

after receiving the request and before the review of the refund request to determine validity.

Appellant points to paragraphs 0092 and Figure 8 to show support for the amendment. However,

Examiner notes that Figure 8 and paragraph 0092 show support for, offering a refund request and

honoring a request, at most. Examiners notes that the claim reads, **paying** the refund request

substantially immediately after receiving the request and before review... *Offering* a refund does

not require paying a refund, similarly, *honoring* a refund request does not require that the refund

is **paid**, let alone **paid** before any review of the refund occurs. Thus, the Examiner maintains

that the Appellant failed to show support for the claim limitations as amended.

Second Issue

Appellant argues (with respect to claim 1) that the term, "substantially", is not vague and

indefinite. However, Examiner notes even if the term is used in conjunction with another term to

describe a particular characteristic as noted by the Appellant, the claim is still rendered

indefinite. Further, Examiner notes that the Appellant's specification fails to disclose any

description or guidance in what the term, "substantially", covers. Thus, one of ordinary skill in

the art would **not** be able to determine the metes and bounds of the claimed invention. There

would not be any possible means for another person to determine whether they would infringe on

Appellant's claims, since the claim recites a vague and indefinite term, such as, "substantially".

Seeing as the specification fails to disclose any support for the term, one of ordinary skill in the

art would not be able to determine the range of the term. Therefore, the Examiner asserts the

claims remain vague and indefinite.

Third Issue

Appellant argues that Montgomery teaches away from the combination of references.

Disclosed examples and preferred embodiments do not constitute a teaching away from a

broader disclosure or nonpreferred embodiments. *In re Susi,* 440 F.2d 442, 169 USPQ 423

(CCPA 1971). "A known or obvious composition does not become patentable simply because it

has been described as somewhat inferior to some other product for the same use." *In re Gurley,*

27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an

epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference

taught a printed circuit material similar to that of the claims but impregnated with polyester-

imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this

use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability"

and "some degree of flexibility," but are inferior to circuit boards impregnated with polyester-

imide resins. The court upheld the rejection concluding that applicant's argument that the

reference teaches away from using epoxy was insufficient to overcome the rejection since

"Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at

1132.). Furthermore, **"[t]he prior art's mere disclosure of more than one alternative does not**

constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, **391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).**

In the instant case, Appellant argues that Montgomery teaches a review of the refund before paying the refund, and therefore the references teach away. However, Examiner notes that this interpretation is incorrect. Examiner notes that Montgomery teaches paying the refund and then entering the portage transaction into a statusing database so that the delivery status can be checked for six months (0170). Thus, the cited references teaches paying the refund before reviewing the refund, and therefore does not teach away, but rather teaches Appellant's invention. Further explanation is provided in the arguments below.

Fourth Issue

Appellant argues (with respect to claim1) that the cited references do not teach or suggest such prompt refund processing followed by determining if the refund request is valid. However, Examiner notes, Montgomery teaches the refund inquiry can take a variety of formats…(1) two or more transactions…(1) the end user's account will be credited for the misprint; (2) the misprint postage transaction information will be date/time stamped in the postage database and flagged as **"refunded"**; (3) a refund request is issued to postage refund request and (4) the refunded postage transaction is entered into a statusing database, so that the delivery status can be checked for six months (0170). Thus, Montgomery teaches if two or more transactions occur, then a user's account will be credited for the misprints, after which monitoring of the statusing database will occur to determine the validity of the refund.

Fifth Issue

Appellant argues (with respect to claim 5) that neither reference teaches or suggests

determining if the mail piece is associated with the user that submitted the refund request.

However, Examiner notes that Gullo discloses, the system should prompt the customer to

provide identifying information concerning the postage transaction for which a refund is sought.

The information sought preferably includes a tracking/label number and transaction number

associated therewith (0018). Thus, Gullo discloses that the tracking number is also associated

with a refund request, where the refund is also incorporated into the indicia. Therefore, the user

is associated with both the refund and the mail piece.

Sixth Issue

Appellant argues that neither reference teaches providing a refund and then performing at

least two observation determinations base upon a refund test period. However, Examiner notes

that Gullo discloses queuing the request for a designated period, for example, seven days, to

check for scan events (0019-0020). Thus, Gullo suggests that more than one attempt to queue

the scan events will occur.

Seventh Issue

Appellant argues that (with respect to claims 11-12 and 16-18) that neither reference

teaches grouping requests for processing. However, Examiner notes that Montgomery teaches a

refund inquiry can also be in the form of an audit review of all postage transaction in a user

account...a refund inquiry can also be in the form of a refund pattern audit...(0175). Thus,

Montgomery teaches a refund request can be for all refunds associated with a user.

Eighth Issue

Appellant argues that neither reference teaches or suggests a refund test period that

depends on the class of service of the mail. However, Gullo discloses the amount of time that

would be considered an undue period may depend on administrator preference, but a period of

between about 1 and 30 days is preferred, with a period of about 10 days being considered

optimal (0019). Further, Gullo discloses the queuing the request for a designated period, for

example seven days, to check for scan events. (This period may be varied) (0020). Also,

Montgomery teaches the refunded postage transaction is entered into a statusing database, so that

the delivery status can be checked for six months (0170, 0174). Thus, Gullo and Montgomery

suggest varying the test period for mail scan events. Furthermore, one of ordinary skill in the art

would recognize that different classes of mail have different mail delivery dates and would

require shorter or longer queuing periods.

Ninth Issue

7.   Appellant argues (with respect to claim 20) that none of the cited references teach

variable test periods based upon the lifetime of the codes. However, Examiner notes that Gullo

discloses that the particular IBI is associate with the tracking/label number and/or transaction

number (0019). Further, Gullo teaches a designated test period, where the period may be varied

(0020). Moreover, Montgomery teaches checking the delivery status for six months (0188).

Therefore, the references teach a variable test period associated with the tracking number.

Tenth Issue

Appellant argues (with respect to claim 21) that none of the cited references teach prior

postage dispense operation association with the user and such variable test periods. Examiner

notes that the claim recites, "…prior postage dispense operation associated with the user and

determining whether the tracking identifier..." Further, Examiner notes that Gullo teaches the

information should further be processed to ensure that the particular IBI associated with the

tracking /label number and/or transaction number was not previously voided or refunded, and/or

that there is not an active scan event for the tracking/label number. If the customer does not

meet the fraud-prevention criteria, then the system denies the request (0019). Therefore, Gullo

teaches that IBI postage dispensed is associated with the user.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Fadey S. Jabr

/F. S. J./

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